

REMARKS

This is in response to the Office Action, Paper No./Mail Date 20070307, mailed on March 15, 2007. Applicant has carefully studied the references cited by the Examiner and the Examiner's comments relative thereto.

Claims 4, 12-13, 15-16, 59, 70, and 75 have been amended.

Claims 1, 2, 3, 14, 79, and 80 have been canceled.

New Claims 81, 82, 83, and 84 have been added to respectively replace canceled Claims 1, 2, 3, and 4.

Claims 10, 11, 67, and 68 are currently withdrawn.

Claims 4-13, 15-16, 59-78, and 81-84, inclusive, are pending in the application.

No new matter has been added.

Acceptance of the drawings filed December 18, 2006 is gratefully acknowledged.

A sincere effort to further define the claimed subject matter responsive to arguments presented by the Examiner and differentiate the claimed subject matter from the prior art has been made in order to place the application in condition for allowance.

Reconsideration of the application, as amended, is respectfully requested. If the Examiner does not feel the Amendment places the application in condition for allowance, entry of the Amendment for purposes of appeal is respectfully requested.

The Examiner rejected Claims 1-16 and 59-80 under U.S.C. 103(a) as being unpatentable over Paskowitz in view of Mayer et al. Independent Claim 1 has been canceled and rewritten as new independent Claim 81 to further define actions to be taken during the grading process that are clearly absent from the teachings of Paskowitz and Mayer et al. Claim 81 recites in part "preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object including visual inspection utilizing at least one of a jeweler's loupe and a magnifying glass" and "generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale".

When terminology in a patent claim requires careful consideration with respect to interpretation, it is important to determine how a person skilled in the art would understand the terminology. A patent applicant is entitled to be his own lexicographer and can modify the

ordinary meaning of a term and have the modified meaning govern claim interpretation. The art of grading objects such as coins, stamps, sports cards and the like, for example, is known by those skilled in the art to require close physical proximity and hands-on visual inspection.

Applicant respectfully submits that Paskowitz and Mayer et al. fail to disclose any physical action or hands-on activity to be performed by the “computer-implemented system” or the “System Manager” whereby the grade of an object is to be determined as disclosed and claimed by applicant. There simply is no provision whatsoever within Paskowitz or Mayer et al. for grading objects by visually examining them as set forth in Claim 81.

Contrary to the Examiner’s assertion, the Applicant respectfully submits that Paskowitz does not teach grading an object based upon a predetermined grading scale and generating a grade indicator for the object. Nor does Paskowitz teach preparing an object for grading and encapsulation by taking physical control of the object. In addition, Applicant respectfully submits that Paskowitz does not teach enabling close inspection of an object including inspection such as by using a magnifying loupe.

It must be understood that at the time of invention, the Applicant faced multiple problems with respect to the exchange of certified objects including coins. The Applicant’s disclosures and prosecution history show that the Applicant as inventor was searching for an “integrated” solution to a number of inter-related problems. The difficulties associated with digital image capture and image delivery via the Internet was one such area of concern. In addition, the Applicant also faced problems relating to posting auction listings on established peer-to-peer trading sites such as eBay™ for example. At best, the Applicant found the trade listing practices (known at the time of invention) to be tedious, time-consuming, inefficient and unnecessarily redundant.

In pursuit of an integrated solution, Applicant realized that one way to solve some of the problems he faced was to improve the method by which objects such as coins are graded and encapsulated thereby making the encapsulated graded coins “trade ready”. With respect to the terminology “trade ready”, the Applicant is entitled to serve as his own lexicographer.

To sufficiently understand Applicant’s use of the “trade ready” descriptor, one must be cognizant of the developmental history of the trade listing process as it relates to on-line commerce sites such as eBay and the like. In the case of eBay (a recognized pioneer in the art), direct interaction with the eBay application programming environment was prohibited. The trade

listing generation process was rigidly defined and there was no mechanism whatsoever by which a seller could streamline the process by interacting directly with eBay's programming environment. All this changed when eBay invited third party software programmers to participate in the development of their own tools enabling third party software applications to directly interact with the eBay platform.

One such development undertaken by the Applicant was the creation of an application to transmit relevant trade data representing graded encapsulated coins directly to the eBay application programming environment without requiring the tedious page by page manual input of data which was previously customary. In doing so, Applicant was able to formulate a vision of the future where sellers of graded encapsulated coins would be aided during the trade listing process and freed from the time consuming tedium formerly imposed by eBay's longstanding manual data entry requirements.

Therefore, "trade ready" encapsulated objects are objects that can be listed for sale in a streamlined manner because the relevant trade data representing such objects is able to be transmitted directly to the ecommerce facility in advance or contemporaneous with the generation of the trade listing process. In the vernacular of eBay's programming environment, this capability is sometimes referred to as Pre-Filled Item Information or the acronym PFII. It should be noted that the reduction to practice of Applicant's invention pre-dates eBay's own implementation and public disclosure of a pre-filled-item information mechanism to streamline the trade listing process.

It would have been impossible, or at least non-obvious, for a skilled artisan to grade and encapsulate using the teachings found in Paskowitz to overcome the limitations of eBay's trade listing mechanism. Combining the teachings of Mayer et al. with selected teachings of Paskowitz also does not render a solution to Applicant's problem.

The Examiner has the burden under 35 U.S.C § 103 to establish a *prima facie* case of obviousness. To do so, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an artisan to combine the relevant teachings of the references.

The M.P.E.P. states:

In order for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. § 2142.

Ultimately, to establish that a conclusion of obviousness is well founded and correct, the Examiner must be able to demonstrate that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention would have selected the applicable elements from the prior art and combined the elements in the manner claimed. With respect to the Examiner's task at hand, it is insufficient to merely articulate what the multiple references disclose. Rather, the Examiner is burdened with the task of showing that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. Furthermore, the Examiner is tasked with the burden of showing that a reference is either in the field of the applicant's endeavor, or is reasonably pertinent to the problem with which the inventor was concerned.

In the instant Office Action, the Examiner cites *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), indicating that a prior art reference must be reasonably pertinent to the particular problem with which applicant was concerned, in order to be relied upon as a basis for obviousness rejection. The Examiner stated:

In this case, the prior art describes the particular problem thus 'When valuable coins are sold or traded, it is often difficult for the purchaser to verify the authenticity and value of the coin being actually purchased. This is because it is easy for an unscrupulous seller to substitute a coin of lesser value for the original coin intended to be purchased. The prior art has recognized this problem and provides for many different types of devices intended to prevent or provide evidence of unscrupulous practices in commercial coin transactions. These devices are generally in the form of a case formed from a pair of transparent plastic plates which sandwich the coin and its authentication certificate therebetween. The plates are then permanently secured together, such as by ultrasonically bonding interlocking edge portions of the plates. The bonded plates form a unitary assembly which is tamperproof and allows the purchaser to view both sides of the coin and determine its authenticity at the time of its purchase.' (Mayer, US Pat. No. 5,042,650: cited in Paper #20060904). It would have been obvious to one of ordinary skill in the art at the time of the invention to look to a reference reasonably pertinent to the particular problem with which the inventor was involved.

However, Mayer et al. fail to teach or suggest any solution whatsoever to the problem facing the Applicant at the time of invention. The general problem facing the inventor was the difficulty he experienced when attempting to sell encapsulated coins via the World Wide Web component of the Internet. The applicant as inventor recognized that significant impediments to the online listing process needed to be overcome in order to generate trade listings in a less cumbersome and more streamlined manner. Ultimately, Applicant realized that one way to solve the problem was to improve the method by which coins are encapsulated, thereby making the encapsulated coins trade ready. The improved method claimed by Applicant was unknown in the art at the time of invention.

Applicant respectfully submits that no motivation, suggestion or teaching can be found within the disclosure of Mayer et al. whereby a person possessing ordinary skill in the art would have concluded that storing both graphical and textual data in a database may provide future utility such as facilitating the generation of trade listings for sellers desiring to exchange certified coins via the World Wide Web. Applicant further submits that Mayer et al. could not anticipate the problems facing the Applicant since the disclosure by Mayer et al. predates the public implementation of web based peer-to-peer trade listing services such as eBay™ and the like.

With respect to the Examiner's citation in the Office Action *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) indicating that a prior art reference must be reasonably pertinent to the particular problem with which applicant was concerned, although applied to Mayer et al. for pertinence, the Examiner ignored and omitted Paskowitz from similar scrutiny. The Paskowitz reference is clearly non-analogous art when compared to the art of authenticating and encapsulating coins. Applicant respectfully submits that the teachings of Paskowitz are not reasonably pertinent to the problem with which the inventor was concerned. Applicant further asserts that simply adding selected teachings of Paskowitz does not solve the problem faced by the inventor. Nor does it cure the deficiencies of Mayer et al.

One defect that is especially noteworthy is the failure of Mayer et al. to disclose activities specifically relating to the grading of coins. The reference does not show that the invention contemplated by Mayer et al. generates a grade indicator for a coin. Similarly, nowhere within the reference can it be expressly shown that the invention contemplated by Mayer et al. provides a grade indicator be encapsulated with a coin. With respect to the combined teachings of Mayer et al. and Paskowitz, the Examiner's assertion that the cited prior art teaches grading an object

based upon a predetermined grading scale and generating a grade indicator for the object as claimed by Applicant is without merit.

In both the most recent and the preceding Office Action, the Examiner stated:

Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs. 1-6, column 3 lines 20-30, column 6 lines 32-58).

The Examiner does not cite Mayer et al. as teaching grading an object based upon a predetermined grading scale and generating a grade indicator for the object. Consequently, any attempt by the Applicant to argue that the combined teachings of Mayer et al. and Paskowitz fail to teach grading an object based upon a predetermined grading scale and generating a grade indicator for the object is necessarily confined to a review of the Paskowitz reference.

With respect to Paskowitz, the Examiner further stated on page 3 of the instant Office Action:

Finally, the prior art discloses the seller citing data characterizing the product or service, including characteristics that are graded, such as reliability. Any grading scale will be predetermined as grades assigned to various comparable objects would be meaningless without a predetermined scale.

The Applicant respectfully submits that the above excerpt from the Office Action completely mischaracterizes the art of grading objects as claimed by Applicant. To illustrate the Applicant's contention, language taken verbatim from the Paskowitz disclosure is presented below:

A first embodiment of the method of the present invention is especially well-suited for conducting electronic commerce on the Internet, but one skilled in the art can appreciate that this embodiment may be adapted to search for information in electronic files of any type. For this embodiment, the following definitions obtain: Descriptive Data – data characterizing an existing product or service. Characteristics include dimensions, color, function, reliability, material content, delivery schedule, and price. These data are cited by a producer or seller of a product or service. (See column 3, line 60 – column 4, line 3).

The above excerpt from Paskowitz explains that the descriptive data is sourced from a seller rather than being determined or generated by the computer-implemented system defined by Paskowitz. Sourcing descriptive data in the manner disclosed by Paskowitz is not the same as undertaking activities requiring close physical contact with tangible objects in order to visually examine them to ascertain the grade of an object. A person of ordinary skill possessing the understandings and knowledge disclosed by Mayer et al. and motivated by the general problems facing the Applicant, would find no structural or functional teaching within Paskowitz relating to the art of grading.

The Examiner further states in the Office Action dated March 15, 2007 that the identity of parties such as sellers and buyers as “users” is non-distinguishing. The Examiner argues that the Applicant’s disclosures taken in their entirety may ultimately be distinguishable if there exists a structural difference between the claimed invention and the prior art structure. The Examiner stated:

If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant has asserted and continues to argue that actions undertaken by buyers within an online commerce environment are distinguishable from actions undertaken by sellers. Furthermore, it is well known in the art that requisite software driven mechanisms that facilitate data queries and searching for products or services of interest to buyers is clearly distinguishable from software driven mechanisms that facilitate trade listing generation. The software based structures that support the actions of buyers are clearly distinguishable from those of sellers. The prior art structure disclosed by Paskowitz is incapable of performing the intended use as claimed by Applicant. The teachings of Paskowitz when combined with Mayer et al. do not cure the defects of Mayer and are therefore incapable of performing the intended use as claimed by Applicant.

As pointed out in the Amendment filed December 18, 2006, Paskowitz actually teaches away from the concept that sellers (as users) can effectively interact with the information system for the purpose of marketing products directly to prospective buyers. Paskowitz fails to make any provision whatsoever whereby a seller acting unilaterally can gain access to stored relevant trade data and list a product or a service for sale by posting a trade listing. Any suggestion that Paskowitz teaches trade listing generation by sellers is completely unsupported by the cited reference. Applicant submits that Paskowitz fails to disclose the requisite steps of a method whereby sellers are provided with access to relevant trade data to generate trade listings for graded encapsulated objects.

Further, there is no suggestion or motivation whatsoever to combine the Paskowitz and Mayer et al. references. The Examiner must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. Applicant respectfully submits that the Examiner has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that a *prima facie* case of obviousness has not been made for at least the above reasons. Accordingly, Applicant respectfully submits that Claim 81 is not obvious under 35 U.S.C. § 103(a) over Paskowitz in view of Mayer et al. Accordingly, Claims 3-16 and 82-83 which depend directly or indirectly therefrom are not obvious under 35 U.S.C. § 103(a) over Paskowitz in view of Mayer et al.

Independent Claims 59, 70, and 75 include at least the same limitations discussed in respect of Claim 81. Accordingly, Claim 59 and Claims 60-66 and 69 which depend directly or indirectly therefrom, Claim 70 and Claims 71-74 which depend directly or indirectly therefrom, and Claim 75 and Claims 76-78 which depend directly therefrom are not obvious under 35 U.S.C. § 103(a) over Paskowitz in view of Mayer et al.

The Examiner's favorable reconsideration of the rejections based upon 35 U.S.C. §103(a) is respectfully requested.

It is submitted that the claims now properly define applicant's invention and distinguish the same from the prior art.

Reconsideration of the application, as amended, is respectfully requested. Accordingly, a formal Notice of Allowance is solicited.

While the applicant's attorney has made a sincere effort to properly define applicant's invention and to distinguish the same from the prior art, should the Examiner deem that other language would be more appropriate, it is requested that a telephone interview be had with the applicant's attorney in a sincere effort to expedite the prosecution of the application.